

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Tomotoshi Sato

Serial No.: 09/668,005

Filed: September 21, 2000

For: VIRTUAL PRINT PREVIEWING

Confirmation No. 8312

Group Art Unit No.: 2179

Examiner: William D. Hutton, Jr.

**Mail Stop Appeal Brief – Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on October 25, 2005.

**I. STATUS OF CLAIMS**

Claims 1-76 are pending in this application, were finally rejected in the Final Office Action mailed on February 11, 2005 and are the subject of this appeal.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1-12, 14-39, 41-56 and 58-76 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Blumberg et al.*, U.S. Patent Application Publication No. US 2003/0140315 A1 (hereinafter “*Blumberg*”).

2. Claims 13, 40 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando*, U.S. Patent No. 6,449,053.

## **III. ARGUMENTS**

In the Examiner’s Answer, the Examiner asserted that the “printing device” recited in Claim 1 includes either a server process or a Web server limitation and then asserted that *Blumberg* discloses this limitation. In support of this assertion the Examiner referred to FIGS. 1A and 1B and the corresponding text on Page 8, line 3 through Page 11, line 21. In FIG. 1A, printing device 102 includes a server process 114 and in FIG. 1B, the printing device 102 includes a Web server 114. See Examiner’s Answer starting at the bottom of Page 4 at the second bullet point, through Page 6, end of first paragraph.

It should be initially pointed out that Claim 1 does not recite that the “printing device” includes either a server process or a Web server, as alleged by the Examiner. Furthermore, the text of the present application at Page 8, line 3 through Page 11, line 21 is clear and unambiguous that the printing devices 102 depicted in FIGS. 1A and 1B are merely example implementations and there is absolutely no indication in the present application that server process 114 and Web server 114 are required elements. Thus, Applicant respectfully submits that in the Examiner’s Answer, the Examiner is attempting to improperly read additional limitations into Claim 1 that are neither recited in Claim 1 nor indicated in the present application as being required.

Notwithstanding the foregoing, the issue of whether the “printing device” recited in Claim 1 includes a server process or a Web server is not germane to the issue at hand, namely, whether the limitations explicitly recited in Claim 1 are taught or suggested by *Blumberg*. Claim 1 is directed to a method for previewing an electronic document that recites:

“generating the electronic document at a client;  
transmitting document information associated with the electronic document from the client to a printing device having a print process for generating hard-copy printouts of electronic documents at the printing device;  
the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client;  
the printing device transmitting the preview document data to the client; and  
previewing the electronic document at the client based on the preview document data received from the printing device.”

The method for previewing an electronic document recited in Claim 1 requires that the printing device have a print process for generating hard-copy printouts of electronic documents at the printing device and that the printing device be capable of generating preview document data based upon the document information received from the client. In the Examiner’s Answer, the Examiner questioned whether the scope of the “printing device” recited in Claim 1 is limited to only printers per se. Examiner’s Answer at middle of Page 27. The answer is the “printing device” recited in Claim 1 is not limited to printers per se. Claim 1 explicitly and unequivocally recites however, that the printing device must at least have “a print process for generating hard-copy printouts of electronic documents at the printing device.” The Examiner may interpret the term “printing device” broadly and may even attempt to read additional limitations from the specification into Claim 1, but the express limitations of Claim 1 itself cannot be ignored.

As previously set forth in Applicant’s Appeal Brief (Pages 5-8), the only printing devices disclosed in *Blumberg* that are capable of generating hard-copy printouts of electronic documents

are local printer 260 and printing devices located at the corporate reproduction center 280, local reproduction center 370 and remote production center 380. *Blumberg* does not in any way teach or suggest that these printing devices can execute the virtual builder software to generate previews of electronic documents or otherwise be configured to generate preview document data and provide the preview document data to a client, as recited in Claim 1. According to *Blumberg*, the virtual builder software “can reside on client computers or server computers, or preferably both.” *Blumberg* at paragraph 0060, lines 2-3. As depicted in FIG. 2 and described in paragraphs [0142] through [0149], the virtual builder software 220 can reside on on-demand print server 210 in corporate intranet 200. As depicted in FIG. 3 and described in paragraphs [0150] through [0153], the virtual builder software 320 can be part of on-demand print service 310 in on-line on-demand print facility 300. *Blumberg* does not teach or suggest that the virtual builder software can reside on a printing device. The figures of *Blumberg* do not depict the virtual builder software 220, 320 executing on a printing device and there is nothing in the text of *Blumberg* to teach or suggest that the virtual builder software 220, 320 could be implemented on a printing device, at least with respect to how Claim 1 defines a printing device. Thus, none of the printing devices disclosed in *Blumberg* themselves generate document preview data.

As for the devices in *Blumberg* that do generate document preview data, i.e., any of the devices that execute the virtual builder software 220, 320, such as on-demand print server 210 and on-demand print service 310, none of these elements can be considered to be a “printing device” as recited in Claim 1, since they do not include a print process for generating hard-copy printouts of electronic documents at those elements. Although these elements may be generally involved in the printing of electronic documents, for example by storing and hosting electronic documents, both on-demand print server 210 and on-demand print service 310 are intermediary

elements that do not themselves include a print process for generating hard-copy printouts of electronic documents at on-demand print server 210 and on-demand print service 310, respectively. In *Blumberg*, all hard-copy printouts of electronic documents are generated at the printing devices, i.e., local printer 260 and printing devices located at the corporate reproduction center 280, local reproduction center 370 and remote production center 380. Thus, none of the printing devices in *Blumberg* generate preview document data and none of the devices that generate preview document data include a print process for generating hard-copy printouts of electronic documents at those devices. The method recited in Claim 1 explicitly requires that the printing device do both. Accordingly, it is respectfully submitted that at least the Claim 1 limitations the “printing device having a print process for generating hard-copy printouts of electronic documents at the printing device” and “the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client” are not taught or suggested by *Blumberg* and that Claim 1 is therefore patentable over *Blumberg*.

In the Examiner’s Answer, the Examiner has failed to rebut the arguments presented in Applicant’s Appeal Brief pertaining to the fact that *Blumberg* does not teach or suggest a method for previewing an electronic document that requires a printing device having a print process for generating hard-copy printouts of electronic documents at the printing device and wherein the printing device generates preview document data based upon the document information received from the client. The only possible assertion made in this regard is that the on-demand print server 210 of *Blumberg* is the “printing device” recited in Claim 1. As fully explained in Applicant’s Appeal Brief and herein, there is no teaching or suggestion in *Blumberg* that the on-

demand print server 210 can itself generate hard-copy printouts of electronic documents at the on-demand print server 210 or in any way includes “a print process for generating hard-copy printouts of electronic documents at the printing device.” The on-demand print server 210 therefore cannot be the “printing device” recited in Claim 1.

In view of the foregoing, it is respectfully submitted that Claim 1 recites one or more limitations that are not taught or suggested by *Blumberg* and that Claim 1 is therefore patentable over *Blumberg*.

#### IV. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is respectfully submitted that the rejection of Claims 1-12, 14-39, 41-56 and 58-76 under 35 U.S.C. § 102(e) as being anticipated by *Blumberg* lacks the requisite factual and legal bases. Appellants therefore respectfully request that the Honorable Board reverse the rejection of Claims 1-12, 14-39, 41-56 and 58-76 under 35 U.S.C. § 102(e) over *Blumberg*. It is further respectfully submitted that the rejection of Claims 13, 40 and 57 under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando* lacks the requisite factual and legal bases. Appellants also therefore respectfully request that the Honorable Board reverse the rejection of Claims 13, 40 and 57 under 35 U.S.C. § 103(a) over *Blumberg*.

Respectfully submitted,

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Date: December 23, 2005

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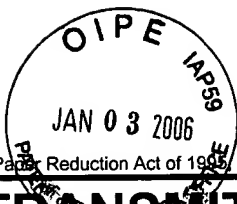
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By



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	First Named Inventor	Tomotoshi Sato	
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